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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,433	12/31/2001	Takeo Kuroda	M&M-048-USA-PCT	4222

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EXAMINER

BERMAN, SUSAN W

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/019,433	Applicant(s) KURODA ET AL.	
	Examiner Susan W Berman	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Response to Amendment

The rejections of claims 5 and 8 under 35 USC 112 are withdrawn in response to the amendment submitted 06-14-2004.

Response to Arguments

Applicant raises a question about acknowledgment of applicant's claim for priority under 35 USC 365. Such a priority claim is made in accordance with 35 USC 119 (a)- (d) and was acknowledged in the Summary page of the Office Action mailed 01-14-12004 and is also acknowledged on the Summary page of the current Office Action. See 35 USC section 365.

With respect to the rejection of claims under 35 USC 102(e) over Baba et al '703: The effective filing date of Baba et al is 06-12-2000 and is before the 08-24-2000 371 filing date of the instant application but after the 08-27-1999 foreign priority filing date of JP 11/241599. A certified translation of the Japanese document would be required to establish the foreign priority date with respect to the Baba et al reference. However, the issue is moot since applicant's arguments for reconsideration on pages 10-11 of the remarks submitted 06-14-2004 have been found persuasive and this rejection is hereby withdrawn. Fujita et al is considered to be close prior art; however, Fujita et al do not teach or suggest irradiation or polymerization initiators activated by irradiation in the disclosed compositions.

Claim Rejections - 35 USC § 102 and/or 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 6-8, 10, 11 and 13-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over J 63-13969. J '969 discloses adhesive compositions. The components taught in the Abstract include compound (A) that contains a hydrolyzable epoxy group and a polymerizable methacrylamido group, thus providing applicant's components (A) and (C) in one compound. With respect to the properties of the adhesive composition set forth in claim 1, the compositions disclosed by the reference would have been expected to have properties within the ranges set forth in the instant claims since the components of the compositions meet the definitions of the required components set forth in the instant claims.

Claims 1, 3, 6-8, 10, 11 and 13-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over J 06080825 (machine translation from JPO website). See the Abstract, claims and paragraph [0019]. With respect to the properties of the adhesive composition set forth in claim 1, the compositions disclosed by the reference would have been expected to have properties within the ranges set forth in the instant claims since the components of the compositions meet the definitions of the required components set forth in the instant claims.

Claims 1, 3, 6-8, 10, 11 and 13-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over J 06-228248 (machine translation). See the Abstract,

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claims, and paragraphs [0019] and [0020]. With respect to the properties of the adhesive composition set forth in claim 1, the compositions disclosed by the reference would have been expected to have properties within the ranges set forth in the instant claims since the components of the compositions meet the definitions of the required components set forth in the instant claims.

Claims 1, 3, 6-8, 10, 11 and 13-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over J 08-325466 (machine translation). See the Abstract, claims, and paragraphs [0070] and [0057]-[0059]. With respect to the properties of the adhesive composition set forth in claim 1, the compositions disclosed by the reference would have been expected to have properties within the ranges set forth in the instant claims since the components of the compositions meet the definitions of the required components set forth in the instant claims.

With respect to each of the rejections set forth above: The burden is hereby shifted to applicant to establish by effective argument and/or objective evidence that the prior art product(s) or process(es) do not necessarily possess the characteristics of the claimed products or processes. Note In re Fitzgerald, 205 USPQ 594 (CCPA 1980). The reference discloses all the limitations of the claim(s) except a property or function and the examiner cannot determine whether or not the reference inherently possesses properties or functions which anticipate the claimed invention. See MPEP 2112-2112.02. Note In re Spada, 911 F. 2d 705, 709, 15 UPQ2d 1655, 1658 (Fed. Cir. 1990), "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not". Note In re Best, 562 F. 2d 775, 195 USPQ 433 (CCPA 1977). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product.

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Claims 1, 3, 5-8 and 10-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0035049 in view of J 55-036241. EP '049 discloses compositions comprising an organic polymer having at least one hydrolyzable silicon-containing groups and a photocurable substance. The photocurable substances specifically taught are (meth)acrylic monomer or oligomers (pages 2-3). Thixotropic agents may be added (page 4, line 7). Curing agents are taught on page 4, however, photoinitiators for the photocurable substances are not mentioned. J '241 discloses adhesive compositions comprising the same organic polymer having a hydrolyzable silicon-containing group and a photocurable substance. J '241 teaches adding a photosensitizer, such as benzophenone.

It would have been obvious to one skilled in the art at the time of the invention to include a photosensitizer, as taught by J '241 in analogous compositions, in the compositions disclosed by EP '049. EP '049 provides motivation by teaching compositions comprising a photocurable substance. J '241 provides motivation by teaching analogous compositions comprising the same kinds of photocurable substances.

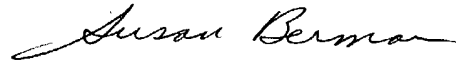
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Susan W Berman
Primary Examiner
Art Unit 1711

SB
August 19, 2004